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EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

2167

DATE MAILED: 12/04/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

TR

# Office Action Summary

Application No.

09/384,182

Applicant(s)

Kay et al

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 5, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29-60 is/are pending in the application.
- 4a) Of the above, claim(s) 48-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 15
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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## **DETAILED ACTION**

### ***Acknowledgments***

1. The amendment filed September 5, 2001 (Paper No. 14) is acknowledged. Accordingly, claims 29-60 remain pending with claims 48-60 withdrawn from consideration in Paper No. 12.

### ***Election/Restriction***

2. Applicant's confirmation of election with traverse of Invention I (claims 29-47) in Paper No. 14 is acknowledged. The traversal is on the ground(s) that the Examiner reasons are conclusory and that "the Examiner has not provided what type of apparatus ... could be used to practice the process. This is not found persuasive.

3. It respectfully submitted that its obvious as to what "apparatus" would perform the method—a stand alone computer with software running on the computer. The Examiner notes Applicant has not argued the Inventions are not patentably distinct, while a requirement for species, the requirement is nevertheless an important factor in restriction practice.

Additionally, the Examiner respectfully disagrees with Applicants' statements that the two invention have not achieved a separate status in the art. Classification of the claimed invention is different that separate status in the art. See MPEP §808.02. Furthermore, because additional classes and subclasses would be required for a proper search of Invention II (e.g. class 709), the requirement is still deemed proper and is therefore made FINAL.

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***Information Disclosure Statement***

4. The information disclosure statement filed September 5, 2001 (Paper No. 15) fails in part to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it omits the place of publication and publication date (month and year). Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

5. The date of “prior to August 1999” is not sufficient for establishing whether the documents are prior art. Applicants may expressly state the documents are prior art, thereby implying the date of publication to be before August 27, 1998. The Examiner notes the publication date is not known so it therefore can not be interpreted as inadvertently omitted.

***Drawings***

6. The appropriate changes required by the Draftsperson’s review (PTO 948 in Paper No. 12) is due. Corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 29-36, 41-46 are rejected under 35 U.S.C. 102(b) as being anticipated by

PowerTV Inc, White Paper titled 'Applications and Service Infrastructure' ("PowerTV").

PowerTV discloses a system with the following: a first plurality of servers (page 18, HTTP Proxy Server, the Local HTTP Server, and the email server) each configured to communicate with a first plurality of network devices (the set-top boxes) associated with a first network (the network connecting the first plurality of servers with the set top boxes), the first servers receive a first product related request from one of the first one of the first plurality of network devices (the user orders products or gets info via email and the world wide web ("WWW")); a second server (a service provider webserver such as compuserve, AOL, earthlink, or mindspring or content sever such as tucows.com) having a first database storing first product related data (to be transmitted, it is stored at least temporarily), to transmit the stored first product related data to the servers (either via email or the WWW in HTML); a central server (at a e-commerce website) storing first and second product related data (price, quantity, and garment size) configured to transmit first and second product related data, to receive the first product related request and to store the received request (the e-commerce sites store the sale information for accounting purposes); the

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first and second product related data stored in the first database are the second product related data transmitted by the second server (i.e., the second server transmits the data from the central server, a common internet function); the first plurality of servers is configured to transmit applications (java executing on the set top boxes or the PowerTV Web Browsers, page 23) operable to receive the product related data (java or web browser data); wherein the first product related data is a request to purchase a product (e.g. purchase a sweater or information via compuserve); the first network is a video broadcast network (figure 2, page 18); the first product related data is different from the second product related data (inherent); the first product related data stored in the first and second databases correspond to a preference of a user associated with a network device (the server stores the user's information accessible with a password); the first product related request (e.g. a request for a particular broadcast video) is transmittable to one of the network devices only if the one network device is tuned to one of the multiple broadcast channels (the operator is allowed to choose the content of programming, page 3); the first product related data transmitted to the one network device is viewable in conjunction with video programming broadcast over one channel (broadcast and two way communications with, for example, on-demand video, page 12).

9. The Examiner notes PowerTV directly discloses connecting the PowerTV to the Internet. Therefore, systems, machines, or other devices connected to the internet and that are old and well known in the art are in essence incorporated into the embodiment of the prior art system.

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***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 37 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over PowerTV. It is the Examiner position that the second plurality of first servers and a third server are either directly or inherently disclosed since the network is connected to the Internet and Internet applications may contain many servers.

However, if not directly or inherently disclosed, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify PowerTV to include the duplicate servers. Such a modification is a mere duplication of parts. See MPEP §2144.04 VI. B.

12. Claims 38-40 rejected under 35 U.S.C. 103(a) as being unpatentable over PowerTV in view of Condon (U.S. 5,956,714). PowerTV discloses as discussed above and does not directly disclose using priority queues. Condon teaches using priority based queues in a plurality of servers to increase efficiency in a database.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify PowerTV as taught by Condon to include the following high

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and low priority queues. Such a modification would have reduced the processing time for high priority queries in the database.

### ***Response to Arguments***

13. Applicant's arguments filed with the amendment in Paper No. 14 have been fully considered but they are not persuasive.

### **The PCT Application**

14. Regarding the PCT written opinion, it is the Examiner's position that this case (09/384,182) is unrelated to the PCT case to which Applicants refer. This application was filed under 35 U.S.C. 111 and not 35 U.S.C. 371. The declaration has been reviewed and there is no indication of any priority claimed. Applicants' arguments are therefore not persuasive.

### **Weight of the Preamble**

15. Regarding the weight of the preamble, these arguments are not persuasive. First, the Examiner agrees with Applicants that "all words in a claim must be considered in judging the patentability of a claim against the prior art, including functional language." It is the Examiner's position that functional language may be found in a claim preamble or in the body of a claim and it makes no difference as to where the functional language is found.



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16. First, Applicant is claiming a “system” in all claims not withdrawn from consideration. “A system is an apparatus.” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). “Claims in apparatus form conventionally fall into the 35 U.S.C. Section 101 statutory category of a ‘machine.’” *Ex parte Donner* 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(citations omitted). Finally, products may be either machines, manufactures, or compositions of matter. MPEP 8<sup>th</sup> Ed., August 2001, §2106 IV A. Any discussion of functional language should then be limited to a system, machine, product, or apparatus as to opposed to a process or method.

17. Next, apparatus claims cover the structure of the machine. One “cannot expand the coverage of apparatus claims to cover every apparatus used for the same purpose.” *Augustine Medical, Inc. v. Gaymar Indus., Inc.*, 181 F.3d 1291, 50 USPQ2d 1900, 1908 (Fed. Cir. 1999). A “use” can only be claimed by claiming the use as a process. See *In re Papesch*, 315 F.2d 381, 384, 137 USPQ 1084, 1088 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). When interpreting functional language, if the prior art is capable of performing the claimed function—even if not directly disclosed—it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (Applicant’s popcorn dispenser was rejected with an oil can because the functional limitations were inherent in the reference). It is the Examiner’s position that the claimed the prior art computer is capable of performing the claimed functions (i.e. the computer is capable of or adapted to receive a first

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product related request through its modem or other connection). Applicants arguments are therefore not persuasive.

18. Second, the Examiner has never stated he has not considered all the words of a claim. The Examiner has never stated that any particular claim language is given no patentable weight. The Examiner's paragraph sets forth how the functional language was considered. While Applicants may disagree with *how* the functional language may be interpreted, an argument that "the Examiner has not fulfilled his duties in examining the claims of the present application by not considering functional language" is clearly incorrect.

In fact, Applicants' arguments support the Examiner position. The phrase "a first plurality of first servers . . . to further transmit" is different from a phrase such as: a first plurality of first servers transmitting a product. The first claimed recitation states what the servers do while the second phrase not found in the claims actually includes transmitting something.

Another example may be of use. A claim reciting "A glove for catching a baseball" is very different in scope than a claim reciting "A glove catching a baseball." The first claim recites a glove and how the glove is used. The second claim actually claims the catching of a ball. An interpretation that the two claims are essentially the same would fail to give any patentable weight to the word "for" and would therefore be improper. Whether its "for" or "to", the words generally denote how the antecedent is used or what it is used for.

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### Additional Arguments

19. Applicants argues “the servers of PowerTV are not each configured to receive a first product related request and from one of the first plurality of network devices as required by claim 29. At best, the Examiner’s arguments are purely speculative as to what information a user might choose to receive from, and/or transmit to, the Internet using the PowerTV system” The Examiner respectfully disagrees.

A “first product request” may encompass purchases at Amazon.com or digital video from a music website. While it may be speculative to ascertain what particular content is request by an internet user, the Examiner notes Applicants have not claimed which particular content is transmitted—only that a “product related request” is transmitted.

Furthermore, Applicant have not claimed that the information is *actually* received, only that its “configured to receive” such information. The “configured to” language is functional language. A coaxial or other digital connection is “configured to receive” virtually unlimited amounts and kinds of information.

20. Applicants argue the servers “are not even a part of the architecture of PowerTV. Since Applicants have claimed a system, there is no requirement that those servers be part of PowerTV. Therefore even if Applicants statements are true, they are unpersuasive.

21. Applicant argues PowerTV does not disclose certain database functions. While the Examiner relies on the reference to disclose some of the “system,” its inherent in the reference

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that servers on the Internet have databases that store information. Again, there is no requirement that PowerTV have the database.

22. Applicant argues it is also “speculated that this e-commerce site stores sale information for accounting purposes.” The Examiner is perplexed at this statement? Are Applicants suggesting that sales data is not stored? That sales data is not retained? The Examiner could not disagree more strongly. How do the businesses pay their taxes, pay there employees, or know how much money the company earns if they don’t keep track of sales data in a database?

### ***Conclusion***


23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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24. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

  
ANDREW J. FISCHER  
PATENT EXAMINER

 12/3/01  
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December 3, 2001